

REMARKS

The Specification has been amended. Claims 16 - 17 and 20 - 29 have been amended. No new matter has been introduced with these amendments, all of which are supported in the application as originally filed. Claims 1 - 40 remain in the application.

Applicant is not conceding that the subject matter encompassed by the claims as presented prior to this Amendment is not patentable over the art cited by the Examiner, as claim amendments in the present application are directed toward facilitating expeditious prosecution of the application and allowance of the currently-presented claims at an early date. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the claims as presented prior to this Amendment and additional claims, in one or more continuing applications.

I. Rejection under 35 U. S. C. §101

Page 3, lines 1 - 3 of the Office Action dated November 21, 2007 (hereinafter, “the Office Action”) state that Claims 20 - 30 are rejected under 35 U. S. C. §101 as being directed to non-statutory subject matter. (Applicant notes that there is a typographical error on Page 3, line 2, where the claims are incorrectly recited as “Claims 20 - 31”.)

Independent Claim 20 has been amended herein, and Applicant respectfully submits that Claim 20 is directed to statutory subject matter as currently presented. Accordingly, the Examiner is respectfully requested to withdraw the §101 rejection of Claim 20 and its dependent

Claims 21 - 30.

II. Rejection under 35 U. S. C. §103(a)

Page 3, last 3 lines of the Office Action state that Claims 1 - 3, 8 - 15, 17, 19 - 21, 24 - 32, and 35 - 40 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 7,096,255 to Malik in view of “the AOL Buddy List FAQ from the year 2000” (hereinafter, “AOL Buddy List”). Page 7, lines 14 - 17 of the Office Action state that Claims 4 - 7, 22 - 23, and 33 - 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Malik in view of AOL Buddy List and further in view of U. S. Patent Publication 2003/0065721 to Roskind. Page 8, lines 16 - 18 of the Office Action state that Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Malik in view of AOL Buddy List and further in view of U. S. Patent Publication 2003/0110044 to Nix et al. Page 9, lines 8 - 10 of the Office Action state that Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Malik in view of AOL Buddy List and further in view of U. S. Patent Publication 2005/0044143 to Zimmerman et al. Page 9, last 3 lines of the Office Action state that Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Malik in view of AOL Buddy List and further in view of U. S. Patent Publication 2004/0172455 to Green et al. Page 10, lines 10 - 11 of the Office Action state that Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Malik in view of AOL Buddy List (and apparently further in view of the Examiner’s Official Notice). These rejections are respectfully traversed.

Section 2143.03 of the MPEP, “All Claim Limitations Must Be Considered” (which is

found within Section MPEP §2143, titled “Examples of Basic Requirements of a *Prima Facie* Case of Obviousness”), quotes *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which held that “*All words* in a claim must be considered in judging the patentability of that claim against the prior art.” (emphasis added)

Furthermore, it is well settled that the claims must be interpreted as a whole. See *In re Sponnoble*, 160 USPQ 237, 243 (C.C.P.A. 1969),

... This is part of the “subject matter as a whole” which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103.

It is also well settled that the teachings of the references must be read as a whole. See *Akzo N.V. v. United States International Trade Commission*, 1 USPQ 2d 1241, 1246 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987), which stated

[P]rior art references before the tribunal must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention. . . . Moreover, [one] cannot pick and choose among individual parts of assorted prior art references “as a mosaic to recreate a facsimile of the claimed invention.” (emphasis added)

In addition, the Court of Appeals for the Federal Circuit has stated, in *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992), that

It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)). (emphasis added)

Referring first to Applicant's independent Claim 1, this claim recites:

A method of managing user information in an instant messaging ("IM") system, comprising steps of:

determining, for an IM client that is operably connected to the IM system, whether any of a plurality of users remembered by the IM client should be treated as expired; and

for each one of the plurality of users for whom the determining step determines that the user is to be treated as expired, omitting this user when performing selected IM management functions of the IM system by automatically remembering that this user is to be treated as expired but not deleting this user from the plurality of users remembered by the IM client. (emphasis added)

With regard to the "... omitting ..." claim language recited on lines 5 - 8 of Claim 1, Applicant explained in his previous Amendment/Response filed September 7, 2007 (see Page 17 thereof) that the cited text in col. 8, lines 23 - 40 of Malik discusses removing temporary contacts who have expired (which is different from the "not deleting" that is recited in Claim 1). The Office Action now admits on Page 4, lines 7 - 8 that Malik "does not explicitly teach not deleting the user from the plurality of users remembered by the IM client" (emphasis added, referencing claim language from line 8 of Claim 1). AOL Buddy List, page 3, is then cited (Office Action, Page 4, lines 9 - 11) as teaching this limitation. Applicant respectfully disagrees that these references can be combined to render his invention obvious under §103, as will now be demonstrated.

Reading Claim 1 as a whole and considering all the words of Claim 1, according to *In re Spinnoble* and *In re Wilson*, a proper §103 rejection of this claim requires that the references must teach that

1. some user "should be treated as expired" (Claim 1, line 4);

2. this user is “omitt[ed] ... when performing selected IM management functions” (Claim 1, lines 6 - 7); and
3. this user is to be “treated as expired but not delet[ed]” (Claim 1, lines 7 - 8).

(These 3 requirements are referred to below as “the 3 requirements for a proper §103 rejection of Claim 1”.)

When reading the references as a whole, as required by *Akzo N.V.*, Applicant respectfully submits that a combination of Malik with AOL Buddy List would not, in fact, yield the invention as claimed in Claim 1 (assuming, *arguendo*, that such combination could be made and that one of skill in the art was motivated to attempt it).

Applicant notes the following statement in Malik at col. 7, lines 46 - 48:

The temporary group **310** will include contact aliases **320**, **325** which the user desires to keep *only* for a limited period of time. (emphasis added)

Applicant interprets this statement by Malik as clearly and unambiguously indicating that the temporary contacts (e.g., users in the temporary group **310**) are to be removed when they expire.

That is, Malik’s user designates the temporary contacts as “temporary”¹ because he desires to

¹ See, e.g., col. 2, lines 1 - 3, “... including [a] temporary contact at the instruction of [the] user”; col. 2, lines 10 - 11, “receiving a request from a user to add a temporary contact”; col. 7, lines 62 - 65, “... the user could add a temporary contact ... by searching for a user and us[ing] a drag-and-drop mechanism to add the contact into the user’s temporary group folder...”; and col. 8, lines 60 - 62, “The first step **400** in the operation is receiving a request [from a user] to add a temporary contact ...”.

keep (col. 7, lines 46 - 48) these temporary contacts only temporarily (i.e., for a limited period of time). In sharp contradiction to the above-quoted statement from col. 7, lines 46 - 48, the Office Action analysis apparently suggests that Malik's user does not, in fact, want to keep the temporary contacts only for a limited period of time. It logically follows that the Office Action analysis is suggesting that Malik's "temporary contacts" should not be temporary.

Alternatively, assuming that the Office Action has properly interpreted the AOL Buddy List as keeping expired contacts, the Office Action assertion that Applicant's claimed "treated as expired but not delet[ed]" (Claim 1, lines 7 - 8) can be achieved by combining AOL Buddy List with Malik may be interpreted as suggesting that it would obvious to keep the temporary contacts even after they have expired, in spite of the fact that those temporary contacts are ones that "the user desires to keep only for a limited period of time".

See also col. 7, lines 39 - 41, "... the universal server **130** includes a database system **250**", which is operable to store a temporary contact alias **300** for a limited duration" (emphasis added) and col. 7, lines 41 - 43, "When the temporary contact **300** expires, the temporary contact alias **300** is removed from the client resource list **305**" (emphasis added).

The suggestion in the Office Action that Malik's expired temporary contacts should not be deleted, but instead should be kept (and apparently "dimmed" according to AOL Buddy List), is in direct contradiction to Malik's description of removing expired temporary contacts. The purported keeping of the expired temporary contacts, as suggested by the Office Action analysis,

also contradicts the “temporary” nature of the temporary contacts. In addition to the above-quoted col. 7, lines 46 - 48 (“... the user desires to keep [the temporary contacts] only for a limited period of time”), additional discussions of this “temporary” nature can be found throughout Malik’s text, including col. 8, lines 29 - 32, “If any of the temporary contacts ... have expired, the service manager **230** can send a request to the database **250**’ to remove the expired temporary contact.” (emphasis added) and col. 8, lines 36 - 38, “... the server can automatically remove the [expired] temporary contact ... from the user profile ...” (emphasis added).

Accordingly, Applicant respectfully submits that the Office Action has failed to interpret the Malik reference “as a whole” and has failed to give “consideration ... where the references diverge and teach away from the claimed [“not deleting”, as claimed in Applicant’s] invention”, and instead has cited individual parts of Applicant’s claim language without regard to the subject matter of the claims as a whole, in violation of the above-quoted *Akzo N.V.* (emphasis added).

Col. 8, lines 41 - 47 discuss an alternative approach to automatically removing expired temporary contacts, where “... the user could be prompted upon the expiration of a temporary contact **300**, but prior to the removal ... [to] afford the user the opportunity to add the temporary contact **300** to the regular resource list **305** ...” (emphasis added). While this moving of the temporary resource from the temporary resource list to the regular resource list avoids removing the contact, this scenario is deemed irrelevant to Applicant’s claimed invention because the moved, now-regular contact is no longer “one of the plurality of users for whom the determining step determines that the user is to be treated as expired”, in contrast to Applicant’s claim language

as recited in Claim 1, lines 5 - 6 (emphasis added).

With regard to the “omitting this user when performing selected IM management functions” as recited on lines 6 - 7 of Claim 1 (emphasis added), the Office Action does not appear to address the “when performing ...” words of this claim language, in violation of *In re Wilson* and *In re Sponnoble*. Col. 8, lines 23 - 40 of Malik is cited (Office Action, Page 4, line 7) with regard to the claim element recited on lines 5 - 8 of Claim 1, but the Office Action provides no hint as to any portion of that cited text from Malik that is supposedly analogous to Applicant’s “when performing” claim language. It appears, in fact, that Malik’s temporary contacts are very much involved in the actions described in the cited text, in sharp contrast to Applicant’s claimed “omitting this user when performing ...” as recited in Claim 1, lines 6 - 7. Col. 8, lines 26 - 29 state, for example, “... service manager **230** could check the expiration periods ... of the temporary group ...”, so it is clear that the temporary contacts are not omitted from the checking process discussed therein. Col. 8, lines 29 - 32 discuss removing temporary contacts by “send[ing] a request to the database”, so the temporary contacts are also not omitted from this processing. Col. 8, lines 33 - 35 discuss “... monitor[ing] the expiration of a plurality of temporary contacts ...”, and this is clearly not omitting such temporary contacts from the discussed monitoring process. Col. 8, lines 35 - 38 discuss “automatically remov[ing] the temporary contact” when it expires, which is clearly not an omitting of the temporary contact from the described automatic removal processing. Finally, col. 8, lines 38 - 40 discuss “not includ[ing] the [expired] temporary contact” from a resource list sent to the client, but when taken in context, it is clear that this “not included” contact is not included *because it has already been*

removed from the user profile **300** (as stated at col. 8, lines 35 - 38). Accordingly, this already-removed temporary contact cannot be equated to a user/contact who is “omitt[ed] ... but not delet[ed]”, in contrast to Applicant’s claim language as recited on lines 6 - 8 of Claim 1.

Referring now to the cited Page 3 of AOL Buddy List, Applicant respectfully submits that this cited text does not cure the above-demonstrated deficiencies of Malik. The cited text says that buddies – which is understood to mean the *graphical representation* of other users – can be set to “dim”. This is clearly a graphical user interface concept and has no bearing on Applicant’s claimed “omitting this user when performing selected IM management functions” as recited on lines 6 - 7 (emphasis added) of Claim 1. In fact, no “omitting” of any type is disclosed or even suggested by the AOL Buddy List citation.

In summary, Applicant has demonstrated that Malik cannot be combined with AOL Buddy List to yield a result having the 3 requirements for a proper §103 rejection of Claim 1, as enumerated above (i.e., in the list that begins “some user ‘should be treated as expired ...’”). Applicant also respectfully submits that the above-presented arguments demonstrate that the Office Action impermissibly picks and chooses isolated parts of the references and then attempts to combine them to recreate Applicant’s claimed invention, even though such combination would contradict the teachings of the references when taken as a whole, in violation of *Akzo N.V.* and *In re Fritch*. Applicant further respectfully submits that this indicates that his claimed invention was impermissibly used as a template, which constitutes impermissible hindsight reconstruction. *Id.*

Independent Claim 1 is therefore deemed patentable over Malik, AOL Buddy List, or any combination thereof (assuming, *arguendo*, that such combination could be made and that one of skill in the art would be motivated to attempt it) . Independent Claims 20 and 31 recite analogous limitations to those of Claim 1, and are rejected using the same analysis (Office Action, Page 6, last 3 lines, and Page 7, lines 5 - 7). Accordingly, Claims 20 and 31 are deemed patentable for the same reasons presented above with regard to Claim 1.

Dependent Claims 2 - 15, 21 - 30, and 32 - 40 are deemed patentable over Malik and AOL Buddy List at least by virtue of the patentability of the independent claims from which they depend. (Applicant notes that dependent Claims 4 - 7, 22 - 23, and 33 - 34 were rejected under 35 U.S.C. §103(a) using Malik, AOL Buddy List, and Roskind. However, Roskind fails to cure the above-discussed deficiencies, and Applicant thus submits that this rejection is overcome.)

Referring next to independent Claim 16, this claim as currently presented recites:

A method of managing user information in an instant messaging (“IM”) system, comprising steps of:

evaluating, for an IM client that is operably connected to the IM system, which of a plurality of users remembered by the IM client should be treated as expired but not deleted from the plurality of remembered users;

providing, for the IM client, a visual indication for the remembered users, in which each one of the plurality of users for whom the evaluating step determines that the user is to be treated as expired is visually indicated differently from ones of the plurality of remembered users that are not to be treated as expired; and

for each one of the plurality of users for whom the evaluating step determines that the user is to be treated as expired, omitting this user when performing presence functions of the IM system by automatically remembering that this user is to be treated as expired but not deleting this user from the plurality of users remembered by the IM client. (emphasis added).

Applicant respectfully submits that Malik, AOL Buddy List, and/or Nix fail to teach or suggest at least the above-underlined limitations of independent Claim 16. Refer to the discussion of similar claim language of Claim 1, above, where this has been demonstrated with regard to Malik and AOL Buddy List. Nix fails to cure the deficiencies of those references, and the §103 rejection of Claim 16 is therefore overcome.

Referring next to independent Claim 17, this claim as currently presented recites:

A method of managing user information in an instant messaging (“IM”) system, comprising steps of:

determining, for an IM client that is operably connected to the IM system, whether any of a plurality of users remembered by the IM client should be treated as expired but not deleted from the plurality of remembered users; and

for each one of the plurality of users for whom the determining step determines that the user is to be treated as expired, providing a different visual representation for this user, as contrasted to the remembered users who are not to be treated as expired, when displaying an IM client display comprising the remembered users to a user of the IM client and omitting this user when performing selected IM management functions of the IM system by automatically remembering that this user is to be treated as expired but not deleting this user from the plurality of users remembered by the IM client. (emphasis added).

Applicant respectfully submits that Malik and/or AOL Buddy List fail to teach or suggest at least the above-underlined limitations of independent Claim 17. Refer to the discussion of similar claim language of Claim 1, above, where this has been demonstrated. Accordingly, Applicant respectfully submits that independent Claim 17 is patentable over the cited references as currently presented. Dependent Claims 18 - 19 are therefore deemed patentable over the references by virtue of (at least) the patentability of Claim 17 from which they depend.

The Examiner is therefore respectfully requested to withdraw the §103 rejections.

III. Conclusion

Applicant respectfully requests reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all claims at an early date.

Respectfully submitted,

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